

REMARKS

Reconsideration and continued examination of the above-identified application are respectfully requested.

The above amendments will place the application either in condition for allowance or in better form for appeal. Entry of this response after final is deemed proper under 37 C.F.R. § 1.116 because: (1) the response raises no new issues; and (2) the application is in condition for allowance, or in better form for appeal. Thus, entry and consideration is respectfully requested.

Claims 1, 3, 18, 19 and their dependent claims (2, 4-17, and 20-29) stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserts that the term "polyalkene radical" is indefinite. Applicants respectfully traverse this rejection for at least the following reasons.

The term "polyalkene radical" has been amended above to more distinctly point out and clarify the claimed subject matter. Withdrawal of this rejection is respectfully requested.

Claim 12 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection for at least the following reasons.

Claim 12 has been cancelled above, thus obviating the present rejection.

Claims 3, 30 and their dependent claims stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner asserts that the claims contain subject matter, which was not described in the specification in an enabling fashion. Specifically, the Examiner asserts that

the PIB-cresol moiety could not possibly have a number average molecular weight of "about 208." Applicants respectfully traverse this rejection for at least the following reasons.

Support for a PIB-cresol moiety with a number average molecular weight of "about 208" is present in the filed specification at, for example, page 9, lines 14-18, Sample B. While it is true that an exemplary number average molecular weight range for R of about 200 to about 5,000 is provided in the specification, it is not true that R "must have a number average molecular weight of from about 200 to about 5,000." The Examiner's attention is respectfully directed to, for instance, page 3, lines 6-8, where suitable R's are described as derived from C₂ to C₂₀ alkenes, without limitation to a particular molecular weight range. Claim 3 has been cancelled above, pending claim 30 is enabled by the filed specification, thus withdrawal of the rejection is respectfully requested.

Claims 3, 30 and 31 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter, which was not described in the specification in a manner so as to reasonably convey to one skilled in the art that the applicants, at the time the application was filed, had possession of the claimed invention. The Examiner asserts that the specification does not support a number average molecular weight of "about 208" for polyisobutylene or a number average molecular weight of "about 325" for unreacted polyisobutyl radical. Applicants respectfully traverse this rejection for at least the following reasons.

Support for polyisobutylene with a number average molecular weight of "about 208" is present in the filed specification at places other than the Sample B on page 9, lines 14-18, for instance, suitable R's are described as derived from C₂ to C₂₀ alkenes, without limitation to a particular molecular weight range at page 3, lines 6-8.

Additional support for polyisobutyl, reacted and/or unreacted, with broader molecular weight ranges can be found at page 3, lines 15-19, where ranges of MN's of "from 200 to 2500", and "from about 350 to about 1500" are described.

Claim 3 has been cancelled above, pending claims 30 and 31 are described by the filed specification, thus withdrawal of the rejection is respectfully requested.

Claims 1, 5-8, 11-13, 15-17 and 23-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stayner (U.S. Patent No. 2,786,745). Applicants respectfully traverse this rejection for at least the following reasons.

Claims 1, 5-8, 11-13, 15-17 and 23-26 have been cancelled above, thus obviating this rejection. Withdrawal of the rejection is requested.

Claims 2, 6, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stayner (U.S. Patent No. 2,786,745). Applicants respectfully traverse this rejection for at least the following reasons.

Claims 2, 6, 27 and 28 have been cancelled above, thus obviating this rejection. Withdrawal of the rejection is requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that presently pending claims 9, 10, 14, 18-22, 30 and 31 are in condition for allowance. Applicants respectfully request reconsideration of the present application and a timely allowance of the pending claims.

Should the Examiner deem that any further action by Applicants' undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.


Except for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17

Appl. No. 10/046,823
Amendment to the Claims dated March 29, 2005
Reply to Final Office Action dated December 7, 2004

which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account No. 06-1135 under Order Number 7391/72568. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. §1.136(a)(3).

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: 
Kendrew H. Colton
Registration No. 30,368

Customer No. 42798
FITCH, EVEN, TABIN & FLANNERY
1801 K Street, N.W. - Suite 401L
Washington, DC 20006-1201
Telephone: (202) 419-7000
Facsimile: (202) 419 -7007